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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/655,930

09/05/2003

Martha Kelsey

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EXAMINER

DOAN, ROBYN KIEU

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

THW

# Office Action Summary

Application No.

10/655,930

Applicant(s)

KELSEY, MARTHA

Examiner

Robyn Doan

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/07/05, 09/07/04; 01/26/04</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The specification is objected to as failing to provide clear support for the claim terminology. 37 CFR § 1.75(d)(1) requires that terms and phrases used in the claims find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. Specifically, the term “manipulative piece” does not appear in the specification.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4-5 and 14-15 are indefinite because it is not clearly understood what is a “manipulative piece”.

In claims 6 and 14, there exist an inconsistency in the claims thus making this scope unclear. Claim 6 recites a first roll and then functionally recites at least one strip, i.e. “is separable into at least one strip”; claim 14 recites a first roll and then functionally

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recites at least one strip, i.e. "is separable into at least one strip", a second roll and then functionally recites at least one strip, i.e. "is cutable into at least one strip" and thus indicating that the claims are directed to the subcombination, a roll of material.

However, further in the claims positively recites the strip as part of the invention (for example, claim 6, line 18 and line 20), thus indicating that the combination of the strip and the roll of material being claimed. As such, it is unclear whether applicant intended the claims to be directed to the subcombination, the roll of material, or the combination, the roll of material and the strip. Applicant is hereby required to indicate whether the claims are intended to be drawn to the subcombination only or the combination and amend the claims to make the language thereof consistent with this intent. For examination purposes, the claims will be considered as drawn to the combination of the roll of material and the strip:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Mosher (U. S. Pat. # 6,782,648).

With regard to claims 1 and 3, Mosher discloses a method inherently for accessorizing the body (figs. 1-3) comprising the step of unrolling a roll of material (12, fig. 3), separating (cutting at 72, fig. 3) the roll into a strip (80), wherein the material including first (82) and second sides and the strip having first (84) and second ends (86), wrapping the strip around a body part (wrist, col. 5, lines 58-60), engaging the first and second ends of the strip to secure the strip on the body part (col. 6, lines 6-10). In regard to claim 6, Mosher discloses a first roll of material (12) being separable into at least one strip (80), wherein the material having first and second sides and the strip including first and second ends (84, 86), an adhesive (48) being disposed on one side of the material, and wherein the strip being adapted to surround a body part, such that the first and second ends are adapted to engage with each other using a fastener (48) which is disposed on one end of the strip. The strip also having an upper surface with information (88) disposed thereon.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6, 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis (U.S. Pat. # 2,399,545).

With regard to claims 6 and 8, Davis discloses a tape (figs. 1-3) comprising a first roll of material (1) being separable into at least one strip (2), wherein the material having first and second sides and the strip including first and second ends (7', fig. 9), an

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adhesive (3) being integrally disposed on one side of the material, and wherein the strip being adapted to surround a body part (6, fig. 9), such that the first and second ends are adapted to engage with each other. In regard to claims 9-10, Davis shows the material being made of a rubber latex material (col. 2, lines 14-15) and being perforated (4, fig. 1 and col. 2, lines 54-56). It is noted that the term "body accessorizing" is a matter of interpretation and intended use, therefore it is not given patentable weight.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mosher.

With regard to claim 2, Mosher discloses a method inherently for body accessorizing comprising all the claimed limitations in claim 1 as discussed above except for the step of stretching the strip in tension. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to stretch the strip in tension, since it is well known in the art to stretch the device in tension depending upon the size of the object it is to be wrapped around.

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mosher in view of Scheggetman (U.S. Pat. # 6,004,643).

With regard to claims 4-5, Mosher discloses a method inherently for body accessorizing comprising all the claimed limitations in claim 1 as discussed above except for the steps of cutting at least one manipulative piece from a second roll of material, wherein the second roll differs in color than the first roll and placing the manipulative piece onto the strip of the first roll. Scheggetman discloses a method of applying one manipulative piece to a roll (fig. 1) comprising a step of cutting at least one manipulative piece (10) from a roll (12, col. 2, line 3) and placing the manipulative piece onto a surface of a second roll (14, fig. 1). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the steps of cutting at least one manipulative piece from a roll of material and placing the manipulative piece onto the strip of the second roll as taught by Scheggetman onto the surface of the strip of Mosher for the purpose of providing a release layer to the strip. Also, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the second roll being made of different colors than the first roll, since such a modification would have involved a mere change in the color of the non critical component. A change in color is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Esmay (U.S. Pat. # 4,522,870).

With regard to claim 7, Davis discloses the tape comprising all the claimed limitations in claim 6 as discussed above except for the adhesive being disposed on the first and second sides of the material. Esmay discloses a roll of tape (18, fig. 2) having a tape with adhesive (24, 26) being applied on each side of the tape. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the adhesive on both sides as taught by Esmay into the strip of Davis for the intended use purpose in a non critical element (specification, page 3, lines 18-23).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mosher.

With regard to claim 13, Davis discloses the tape comprising all the claimed limitations in claim 6 as discussed above except for the first and second ends of the strip being engaged using a fastener disposed on the first and second ends of the strip. It would also have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the other end with a fastener, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mosher in view of Vesey (U.S. Pat # 6,455,752).

With regard to claim 11, Mosher discloses the tape comprising all the claimed limitations in claim 6 as discussed above except for shapes created from a second roll of material and wherein the roll being a different color from the first roll. Vesey discloses



a decorative bandage kit (fig. 4) comprising shapes (14, 11). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ shapes as taught by Vesey into the strip of Mosher for the decorating purpose. Applicant will note that the limitations "created from a second roll" is directed to a process of making the device and, as such, is not given patentable weight in an article claim. Also, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the second roll having a different color than the first roll, since such a modification would have involved a mere change in the color of the non critical component. A change in color is generally recognized as being within the level or ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over McAllister (Patent Application Publication # US2003/0009921) in view of Mosher.

With regard to claims 6 and 12, McAllister discloses a device for body accessorizing (figs. 1-2) comprising a strip (1) having a first and second end wherein the first and second ends being engaged to a body part (fig. 2) using self-adhesive property (paragraph 6, 7). McAllister does not disclose the strip being separable from a roll, however Mosher, as discussed above, discloses a strip being separable from a roll. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the roll as taught by Mosher into the strip of McAllister for the purpose of providing large quantities of wristbands in a big event.

Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis.

With regard to claims 14 and 15, Davis as discussed above discloses a first roll (1, fig. 1) of self adhesive (3) perforated (4) rubber material (col. 2, lines 14-15) that is separable into at least one strip (2), wherein the material including a first and second side and the strip having first and second ends (7'); the strip being adapted to surround a body part (6, fig. 9), such that the first and second ends are adapted to engage with each other. Davis does not disclose a second roll of self adhesive perforated rubber material that is cutable into at least one manipulative piece, wherein the material including a first and second side, the first and second roll differ in color. It would also have been obvious to one having an ordinary skill in the art at the time the invention was made to construct a second roll of self adhesive perforated rubber material that is cutable into at least one manipulative piece, wherein the material including a first and second side, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. And it would also have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the second roll to having a different color than the first roll, since such a modification would have involved a mere change in the color of the non critical component. A change in color is generally recognized as being within the level or ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mennie et al and Hsueh are cited to show the state of the art with respect to a wristband with adhesive property. Mazza et al and Cooledge et al are cited to show the state of the art with respect to a roll that is separable into a strip of material. Stchowski is cited to show the state of the art with respect to a hair styling device with self-adhesive property.

The drawings filed 09/05/2003 have been approved by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (571) 272-4711. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Robyn", with a long horizontal flourish extending to the right.

Robyn Doan  
Examiner  
Art Unit 3732